

discussed more fully below, amended independent claims 1, 10 and 19 are neither taught nor suggested by the Borkowski Patent. Applicant respectfully traverses the rejection and requests reconsideration in view of the following remarks.

Applicant has amended Independent claims 1, 10 and 19 and added new claim 32 to clarify that: (1) only the window area of the test tape is transparent, (2) the test tape is not permanently affixed to the slide, but is applied to the slide after collection of the environmental sample, and (3) the sample collected is an environmental sample suspected of containing mold. Claims 10, 19 and 32 also require an area adjacent the window area that is non-transparent. Claim 10 further requires that this area adjacent the window area be adapted for recording information about the environmental sample thereon.

Support for these amendments is in the original specification and claims. Of particular interest, it is noted that the drawings show that the test tape is designed to be transparent and viewable only through the window. The remainder of the tape is non-transparent and provides a means for recording information regarding the collected sample. This is shown in the drawings wherein the alignment indicia 240 on the placard 200 shown in FIG. 3, are no longer visible once the transparent panel 210 containing the tapes 100 is placed over the alignment indicia 240 as shown in FIG. 4. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d 1111, 1116 (Fed. Cir. 1991) ("drawings alone may provide a 'written description' of an invention as required by § 112"); Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc., 62 U.S.P.Q.2d 1846, 291 F.3d 1317 (Fed. Cir. 2002) ("Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed.").

The Borkowski Patent does not teach or suggest a test tape in which the sample is visible or viewed only through a limited window area. The Borkowski Patent shows a test tape that may be viewed both inside and outside of a circle on the tape, since the entire tape is comprised of transparent Scotch Tape®. See column 4, lines 25-26. As discussed in Applicant's specification, the problem with conventional sampling techniques is that the laboratory worker must select which portion of the tape to read under the microscope. Many laboratory clients submit excessively large samples hoping all of it will be read. The test tape of the present invention makes clear to a client that only the transparent window area is available for examination of the sample (because there is a place on the tape for writing information and/or for handling), such that they will understand there is no need or purpose to take an overly large sample. Furthermore, the confined area of the examination window allows standardization of the surface tape lift sample method, whereas prior methods did not have a standardized area of examination. In addition, it is often difficult to find the sample when using the microscope – even using tapes like those in the Borkowski Patent – since it is possible that the user will focus on the transparent areas outside the window. In addition, important information may be missed due to the selection choice. Applicant's claimed test kit offers distinct advantages compared to the fungus skin detection kit of Borkowski because Applicant's test kit clearly specifies a limited area of the tape to be viewed under the microscope. A viewer will immediately know that he/she is looking at the correct sample area because the areas outside the window are not visible. By having the window surrounded by a material that is not transparent, the sampling technique is markedly improved.

The Borkowski Patent also does not teach or suggest a test tape in which the area surrounding the window is adapted for recording information thereon. Instead, the Borkowski

Patent suggests that a separate data form be provided with the kit for recording information. See column 4, lines 9-16.

The Borkowski Patent also does not teach collecting an environmental sample, namely surface dust or mold from a carpet, window sill, furnace filter or other inanimate object, but is instead directed to collecting "a superficial skin lesion from an individual's body" for medical diagnostics. See column 1, lines 66-67 to column 2 lines 1-8. Borkowski actually teaches away from use of its kit in collecting an environmental sample by teaching that it is preferred to have the end of the tape permanently attached to the end of the slide, such that the tape is peeled back, the slide and tape are turned over, the patient positions his/her skin lesion against the tape, the slide and tape are returned to an upright position and the tape is then returned to position over the slide. See FIG. 7 and column 3, lines 39-41 and 55-65. While having the tape permanently attached to the slide will work when sampling a part of a moving person's body, it would not be suitable when taking environmental samples from furniture or other substrates. The slide would get in the way of collection and would likely become contaminated by adjacent surfaces and handling. Claims 1, 10 and 19 require that the tape is only attached to the slide after the environmental sample is collected. This allows for superior flexibility in collecting the sample, which was not contemplated by Borkowski. Additionally, displacement of the window as required by claim 5, 28 and 32 prevents contamination of the sample area by the sampler and prevents the sampler from himself coming into contact with potentially harmful contaminants.

Independent claim 19 also requires "a placard for releasable affixation of said slide thereto."¹ Applicant respectfully submits that the Borkowski Patent does not teach or suggest a

¹ Applicant has broadened claim 19 to remove reference to the alignment means on the placard and has submitted new dependent claims directed to such an alignment means.

kit that includes a placard. Instead, the Borkowski Patent discloses that its slide with the skin sample is placed in a bag having a zip-type closing mechanism. Furthermore, Borkowski does not contemplate the convenience and efficiency of having multiple tapes per slide as required by claims 8, 11 and 29. See FIG. 3., column 3, lines 49-51.²

C. Section 103

The Examiner rejected dependent claims 3, 8, 11, and 15 as being unpatentable over the Borkowski Patent in view of Dimou et al., U.S. Patent No. 5,766,677 ("the Dimou Patent"). Applicant respectfully traverses each of the rejections and requests reconsideration.

As to claims 3 and 15, the Examiner argues that the Dimou Patent teaches a cover slip for a microscope slide having viewing fields marked thereon in the form of a grid such that it would be obvious to put such a pattern on Applicant's test tape. However, as stated in MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In this instance, Applicant's claimed grids are provided on a test tape that is used to collect the environmental sample, not merely to view the sample. By having the grids on such a collection tape, the position of the lines of the grid are fixed and cannot move around over the viewing area or be positioned and repositioned in a variety of locations, as may happen when there is a sample covered with a coverslip having a grid. Thus, when the environmental sample adheres directly to the grid of the collection tape, it is possible for designated particles to be relocated at a different time according to the permanent demarcations of the grid. Applicant submits the Dimou Patent is not concerned with collection of the sample at all and that the

² For similar reasons, Applicant traverses the rejection of dependent claims 2, 7, and 16, all of which recite a placard.

coverslip grid is merely placed on top of a sample in an arbitrary position. Since it is not permanently fixed, it may be repositioned accidentally during processing, during microscopic examination (by contact with the oil immersion objective), during storage, or in a variety of other ways. Thus, relocating a microscopic particle during a subsequent session would be extremely difficult or even impossible.

Applicant also respectfully traverses the Examiner's rejection of dependent claims 8 and 11 under Section 103. Claim 8 recites a slide for configuration of a plurality of test tapes thereon. In addition, Claim 11 recites that there are a plurality of test tapes where "said test tapes attached to said slide." Thus, in Applicant's claimed invention, the slide acts as an enlarged microscopic slide – permitting the user to view not one, but a plurality, of environmental samples. Claims 8 and 11 and new claim 29 require multiple test tapes that can be laid horizontally, allowing the window of each tape to be aligned vertically in a row in accordance with the underlying indicia of the placard. After removal of the slide from the placard, the slide can be turned 90 degrees clockwise and then placed on a typical microscope stage. The multiple viewing windows now form a horizontal row on the slide. All parts of the horizontal row of viewing windows can be examined successively in a convenient and efficient manner using a typical microscope without the need to further turn or remount the slide, since all parts of the transparent windows are within viewing range. This saves time because the viewer need not mount multiple slides.

The Examiner argues that it would be obvious to include a plurality of test tapes in the kit of the Borkowski Patent to allow several samples to be taken and sent to the laboratory. However, the Borkowski Patent teaches a single piece of tape 2 attached to a single piece of glossy paper 6. See Figures; column 3, lines 33-36. Moreover, the Borkowski Patent actually teaches away from the claimed invention. Indeed, Borkowski teaches that when multiple

samples were viewed, each sample was "touched with a piece of Scotch tape" and "the tape fragments were th[e]n attached to glass slides" (column 4, lines 24-25). Thus, the Borkowski kit is much more time consuming than Applicant's claimed invention because Borkowski's tape must be individually mounted to a slide on a microscope and then viewed. For this reason, Applicant requests that the Examiner withdraw the rejection to claims 8 and 11 under Section 103.

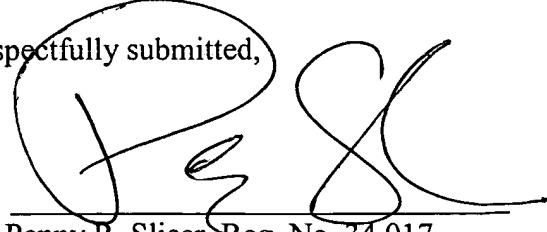
D. New Claims

Applicant has also added several dependent claims in order to point out additional patentable aspects of the invention. No new matter has been added by these claims. See paragraph [0020] describing slots 230 and FIGs. 3, 4 showing slots (**Claim 21**); paragraph [0020] describing placard with alignment indicia 240 with preprinted outline of slide and FIG. 3 showing same (**Claims 22, 23**); paragraph [0022] and FIGs. 3-4 showing placard with preprinted area 222 for recording information (**Claim 24**); paragraph [0019] and FIGs. 1, 2, 4, and 5 showing area 122 for recording information on the tape (**Claim 25**); FIGs. 1, 2, 4, and 5 showing curved edge of tape (**claim 26**); paragraph [0019] and FIGs. 1, 2, 4, and 5 for "displaced" handling area (**claim 27 and 28**); paragraph [0020] and FIGs. 4 an 5 for aligned row of window areas for successive examination (**Claim 29**); and paragraph [0018] and FIG. 1 for test tape attached to backing with instructions for use thereon (**Claims 30 and 31**).

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, she is invited to contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

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